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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/209,706	12/11/1998	EDWARD F. TOKAS	IR-2588(ET)	6621

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/209,706

### Applicant(s)

TOKAS ET AL.

### Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 54, 59-62, 65-83, 93, 94, 96, 98-102, 104-107, 110-114, 117-142, 148, 150 and 160 is/are allowed.
- 6) ☒ Claim(s) 56, 57, 63, 64, 115, 144-146, 153-155, 158, 159, 164-166 and 169-171 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 54,56,57,59-83,93,94,96,98-102,104-107,110-115,117-142,144-146,148,150,153-155,158-160,164-166 and 169-171.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-24-2003 (as corrected with the submission on 12-19-2003) has been entered.

2. Claims 56, 57, 63, 64, 115, 144, 145, 146, 153-155, 158, 159, 164-166, 169, 170 and 171 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 56, 57 and 64 define that the substrate is an elastomer - claim 99 however has been amended to define that the substrate is a *metal substrate* whose surface is being coated - this contradiction with claim 99 raises confusion in determining the scope of these claims. A similar contradiction is presented by claim 146.

Claims 63 and 115 indicate that the catalyst is included as a component of the substrate resulting from mixing the catalyst in bulk with the material forming the substrate. With the amendment of claims 99/104 to restrict the substrate to a metal substrate, however, it is not considered that claims 63/115 are consistent with claims 99/104. In other words, it is not considered a reasonable reading of the original disclosure that this bulk mixing was meant to apply to a metal substrate and an ambiguity is therefore raised by this apparent inconsistency. Note also a 35 USC 112, first paragraph rejection to follow.

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In claim 144, "machined metal part" is repeated.

It is not seen how claims 153 or 164 further limit the claims from which they depend. A metal substrate must comprise a metallic material - if not, then it is not clear what is meant by "metal substrate".

Claim 159 and 170 define that the metal substrate is a machined part made from metal and elastomer. This however raises confusion in determining exactly what is being coated - in other words, claims 99 and 104 were read to require that it is a metal substrate that is being coated. Claims 159 and 170 however arguably confuse or contradict these claims in that they indicate that the metal substrate may not actually be metal and in fact includes elastomer, this seemingly then opening up the material that is being coated to elastomers rather than being restricted to metal as the independent claims were read as requiring. This therefore presents significant confusion.

In claim 171, no antecedent has been established for "said non-fibrous substrate" - it appears this should refer to the metal substrate.

3. Claims 63 and 115 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 63 and 115 indicate that the catalyst is included as a component of the substrate resulting from mixing the catalyst in bulk with the material forming the substrate. With the amendment of claims 99/104 to restrict the substrate to a metal

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substrate, however, claims 63/115 are considered to define an invention that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention - i.e. it is considered to introduce new matter. In other words, it is not considered a reasonable reading of the original disclosure that this bulk mixing was meant to apply to a metal substrate and as such, it is not considered that this combination was originally described.

4. Claims 54, 59-62, 65-83, 93, 94, 96, 98-102, 104-107, 110-114, 117-142, 148, 150 and 160 are allowed, the following comments on the reasons for holding these claims allowable supplementing the 12-19-2003 amendment and applicant's remarks accompanying that amendment.

Among the closest prior art, WO97/38036 to Ciba Specialty Chemicals and Brown-Wensley et al. (US 5,491,206) were applied as exemplary of the known application of a variety of metathesis polymerizable materials as coatings on a wide variety of substrates. These references however do not teach or suggest formation of the coating by providing the metathesis catalyst at the substrate surface prior to contacting with a material that undergoes a metathesis reaction to form a coating as claimed. Lesser (US 2,978,354), Cole et al. (US 3,485,655) and Krieble (US 2,901,099) were applied as evidence that it is known when forming catalyzed coatings on substrates to provide the catalyst at the substrate surface rather than mixed with the coating polymer to be applied for the advantage of avoiding the shortened pot life of polymer/catalyst mixtures as well as avoiding complicated and costly methods of mixing

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the catalyst during the e.g. spraying of the coating. None of these references however specifically suggest metathesis catalysts/polymer systems. EP 424,833 is also directed to metathesis polymerization and indicates that the need for a separate mixing of the monomer with a catalyst stream can be obviated if the catalyst is first applied to a substrate surface - this reference however is directed to forming molded products rather than coating a metal substrate as claimed.

The declaration under 1.132 filed 4-14-2003 shows (in "Part 2") that with the same material to be catalyzed, the same metathesis catalyst and the same metal substrate, a significantly and unexpectedly better coating adhesion was present following the invention, in which the metathesis catalyst was preapplied to the metal substrate, rather than when premixed with the polymer, it being noted that none of the above noted references would have indicated that an improved coating adhesion would have been expected if the catalyst were preapplied. Table 13 in the original disclosure further shows that although relatively poor coating adhesion results were present for some plastic or elastomer substrates, the results for all of the listed metal substrates are either "excellent" or "very excellent".


Taking all the above noted prior art and other evidence as a whole and on balance, it is not considered that the invention as claimed would have been taught or obvious from the closest prior art.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Geoffrey L. Knable  
Primary Examiner  
Art Unit 1733

G. Knable  
March 7, 2004